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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/508,903 | 09/23/2004 | Toshinori Ikehara | 5404/90 | 8359 |

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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1655

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/508,903

Applicant(s)

IKEHARA ET AL.

Examiner

S. B. McCormick-Ewoldt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9-23-04, 12-13-04, 8-19-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment of September 23, 2004 is hereby acknowledged and entered.

Claims Pending

Claims 1-15 will be examined on the merits.

Information Disclosure Statement

The references, A8, A10 and A11, filed September 23, 2004 have not been considered because there are no translations provided.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation "by weight" is indefinite because it is not known what is encompassed. Is this weight of the entire composition or as a ratio to another component in the composition? Clarification is needed,

In claim 1, the term "using" is indefinite because it is not known how the solvent is used. Clarification is needed.

Because claims 2-15 depend either directly or indirectly upon claim 1, these claims are also indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-8, 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tagawa *et al.* (JP 02000239176A- translation provided).

Tagawa *et al.* (JP 02000239176A) expressly teaches obtaining a hydrophobic component from licorice (i.e. *Glycyrrhiza glabra*) by using the organic solvents of ethanol or ethyl acetate to obtain 10% or more by weight of a polyhydric-alcohol fatty acid ester. The polyhydric-alcohol fatty acid ester used is glycerol and also a diglycerol and triglycerol. (see [0006], [0009]-[0012], [0015]). Thus, Tagawa *et al.* meet the limitations of claim 1 as the process for producing an oil and fat composition, which comprises hydrophobic components of licorice and thus anticipates the claimed invention. The amount of 10% as required by the claims is arbitrarily directed toward any amount because it is not understood what this percentage is referring to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

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invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being obvious over Tagawa *et al.* (JP 02000239176A- translation provided) in view of Mae *et al.* (US 2004/0028751) in view of JP2000-204370 (translation provided).

Tagawa *et al.* (JP 02000239176A) disclose obtaining a hydrophobic component from licorice (i.e. *Glycyrrhiza glabra*) by using the organic solvents of ethanol or ethyl acetate to obtain 10% or more by weight of a polyhydric-alcohol fatty acid ester. The polyhydric-alcohol fatty acid ester used is glycerol and also a diglycerol and triglycerol. (see [0006], [0009]-[0012], [0015]). Tagawa *et al.* do not disclose using polyglycerol condensed ricinoleic acid ester.

Mae *et al.* (US 2004/0028751) disclose a licorice oily extract that can be used for a food additive ([0017]). The hydrophobic fraction of licorice is extracted out by using any solvent suitable for use in pharmaceutical products, food and food additives. The solvents include ethanol, acetate and ethyl acetate.

JP2000-204370 discloses mixing polyglycerin fatty acid condensed-ricinoleic acid ester when obtaining a fat composition that contains polyphenols because the condensed-ricinoleic acid ester is used as an emulsifier, which will help mix the oil.

The references taken together disclose the ingredients for producing an oil and fat composition containing hydrophobic components of licorice. The references show that it is well known in the art to use ethanol, acetate and ethyl acetate in extracting out hydrophobic fractions from licorice and using polyhydric-alcohol fatty acid ester to combine with the hydrophobic components of licorice. As disclosed in Mae *et al.*, the hydrophobic component of licorice used in foods and food additives. JP2000-204370 discloses that condensed-ricinoleic acid ester is used because it acts as an emulsifier, which helps mix the fat and oil of the composition. Thus, a

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person of ordinary skill in the art would reasonably expect that a process for producing an oil and fat composition containing hydrophobic components of licorice could be made as taught by Tagawa and Mae; and as disclosed in JP2000-204370 condensed-ricinoleic acid ester would be added which acts as an emulsifier. Based on this reasonable expectation for success, a person of ordinary skill in the art would be motivated to modify the teachings of the references.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Summary

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

PATRICIA LEITH
PRIMARY EXAMINER
